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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/775,568	02/10/2004	Norbert Miller	SWR-0130	1477
23413	7590	06/20/2007		
CANTOR COLBURN, LLP 55 GRIFFIN ROAD SOUTH BLOOMFIELD, CT 06002			EXAMINER SHAPIRO, JEFFERY A	
			ART UNIT 3653	PAPER NUMBER
			MAIL DATE 06/20/2007	DELIVERY MODE PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

## Office Action Summary

Application No.

10/775,568

Applicant(s)

MILLER ET AL.

Examiner

Jeffrey A. Shapiro

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 29 March 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1,2,4-9 and 11-23 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,2,4-9 and 11-23 is/are rejected.
- 7) ☒ Claim(s) 15 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 10 February 2004 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)          | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

### ***Drawings***

1. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the structure through which coins are passed from the "coin insertion slot" (13) to the "rollers" (2a, 2b) must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

### ***Specification***

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2. 35 U.S.C. 112, first paragraph, requires the specification to be written in "full, clear, concise, and exact terms." The specification is replete with terms which are not clear, concise and exact. The specification should be revised carefully in order to comply with 35 U.S.C. 112, first paragraph. Examples of some unclear, inexact or verbose terms used in the specification are as follows.

3. For example, in paragraph 6, there is mention in line 17 of an "opposite" roller to the two rollers. The specification should be checked for completeness with regards to elements and their structural relationships to each other that are required to practice the invention as well as the clarity and thoroughness of explanation. As an illustrative example, note that paragraph 6 describes that the coins can be brought to the rollers by either slanted plane (1), funnel (3) or slot (13).

#### ***Claim Objections***

4. Claim 15 is objected to because of the following informalities: Claim 15 would be better grammatically to read as "wherein the coin insertion slot is funnel-shaped".

Appropriate correction is required.

#### ***Claim Rejections - 35 USC § 112***

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claim 4 is again rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

It is unclear what is meant by the phrase "rotated in response to the coin supply".

In other words, how does the coin supply effect the rotation?

7. Claim 4 recites the limitation "the coin supply" in line 2. There is insufficient antecedent basis for this limitation in the claim.

8. Claims 7 and 8 are again rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

It is unclear how the pair of rollers can pass coins through a bypass connected to a coin insertion slot, since figure 1 seems to illustrate that the coin insertion slot (13) has no connection either to funnel (3) or to rollers (2). Instead, it illustrates that coins are inserted in coin slot (13) and fall down bypass (7) into container (14).

9. Claim 12 is again rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

It is unclear what relationship there is between the "processing device" and the other structural elements.

### ***Claim Rejections - 35 USC § 102***

13. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

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14. Claims 1, 2, 4-6, 9, 11, 12 and 19-23 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Shirasawa (US 5,355,988).

Regarding **Claims 1, 9, 12, 20 and 23**, Shirasawa discloses providing at least one pair of rollers (35-38 and 47), which separate coins into a singulated flow regardless of their value (see figure 4), said rollers rotating in the same rotational direction, as illustrated in figures 4-8, said rollers rotating in the same direction, i.e., counter-clockwise, to be further processed by a coin processing device (55, 56). The conveyor (30) conveys coins to the rollers (47 and 35) which rotate in the same direction. This separates the coins, which are then transported by conveyor (31) away from said pair of rollers to be further processed by processing device (55, 56), i.e., a sensor as referred to in **Claim 19**.

Regarding the spacing between Shirasawa's rollers, note col. 1, lines 58-66, which states that the spacing "D" is greater than the thickness "T" of the coin, said spacing also being less than twice the thickness "T".

Regarding **Claim 2**, Shirasawa discloses belt (45) that connects both rollers (35 and 47) to a drive mechanism (41 and 42), thereby rotating them at the same rotational speed. See Shirasawa, figures 2 and 5.

Regarding **Claim 4**, Shirasawa discloses rotating the rollers in response to the coin supply through means of microcomputer (43), signal generators (70, 71) and buttons 9-12. See col. 4, line 55-col. 5, line 40.

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Regarding **Claim 5**, Shirasawa discloses a collection container (17) where processed coins are stored.

Regarding **Claim 6**, Shirasawa discloses conveying the coins in series from the pair of rollers to processing device (55, 56).

Regarding **Claims 9, 11 and 21**, further note sloped surfaces (31) as well as sloped surfaces (14a, 15a and 61).

Further regarding Claim 9, note that per MPEP 2115, the "material or article worked upon does not limit apparatus claims". As such, the limitations regarding the thickness of the smallest and largest coins, i.e., the articles being worked on, do not hold patentable weight and are not being considered with respect to Claim 9.

Regarding **Claim 22**, note that Shirasawa discloses a cover (8a) that is removable and located in an area of the means of transportation.

At the time of the invention, it would have been obvious to one of ordinary skill in the art to have maintained a space between the rollers that is larger than the thickness of a thickest coin, but less than the thickness of the smallest coin handled by the machine. Note that it is a matter of design choice as to what coins are handled by Shirasawa's machine, based on the requirements of the gaming machine payouts. As an example, if the thickest coin handled was a US quarter, and the smallest was a US dime, then the spacing would necessarily be greater than the quarter's thickness, but smaller than twice the dime's thickness.

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In the alternative, if the machine only accepts one type of coin, such as a quarter, then the thickest and smallest thicknesses will be equal. Thus, in such a case, Applicants' claimed spacing formula would be anticipated by Shirasawa.

Therefore, because it is a matter of design choice as to what the smallest coin handled by the sorter is, or, in the alternative, because Shirasawa discloses that the smallest and largest coin are of equal thicknesses Applicant's claims are considered to read on Shirasawa's claimed spacing formula.

***Claim Rejections - 35 USC § 103***

15. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

16. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).



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17. Claims 7, 8, 13 and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shirasawa (US 5,355,988) in view of Bruner et al (US 5,988,349).

Shirasawa discloses the apparatus described above.

Regarding **Claims 7 and 13**, Shirasawa does not expressly disclose, but Bruner discloses a bypass return chute placed before a "further processing device" for the purpose of removing coins of incorrect diameter. See Bruner, col. 5, lines 15-25.

At the time of the invention, it would have been obvious to one of ordinary skill in the art to have included a return chute placed before the coin processor/sensor for the purpose of removing coins of improper diameter, thus allowing the size of the "rejector" to be reduced. See again, Bruner, col. 5, lines 15-25.

Regarding **Claims 8 and 18**, it would have been obvious to one of ordinary skill to have removed the coins of improper diameter before the rollers because one ordinarily skilled would have recognized that such coin races and return chutes as taught by Bruner requires coins to be discriminated by gravity developed by dropping the coins in a vertical direction rather than in a horizontal direction. Once the coins of improper diameter have been removed, the coins of proper diameter drop onto the horizontally displaced coin conveyors to transport them to said rollers and the further coin processor.

18. Claims 14, 16, 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shirasawa (US 5,355,988) in view of Masse (US 5,713,451).

Shirasawa discloses the coin handling device described above.

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Regarding **Claims 14, 16 and 17**, Shirasawa does not expressly disclose, but Masse discloses a coin slot (2) for the insertion of a single coin (A), having a slot closure plate (32), that is selectively closed by solenoid (28). See figures 3 and 4 of Masse.

At the time of the invention, it would have been obvious to one of ordinary skill in the art to have incorporated the coin slot and closure plate in Masse.

The suggestion/motivation to do so would have been to secure the coin system by prevent foreign matter from entering the coin apparatus.

19. Claim 15 is rejected under 35 U.S.C. 103(a) as being unpatentable over Shirasawa (US 5,355,988) in view of Masse (US 5,713,451) and further in view of Jones et al (US 2003/0127299 A1).

Shirasawa discloses the coin apparatus described previously.

Regarding **Claim 15**, Shirasawa does not expressly disclose, but Jones discloses a coin input area (14) that is generally funnel-shaped. See figure 1 and paragraph 17.

At the time of the invention, it would have been obvious to one of ordinary skill in the art to have made Shirasawa's coin input area funnel-shaped, for the purpose of directing the coin to a processing area. See paragraph 17, lines 1-4.

### ***Response to Arguments***

20. Applicant's arguments with respect to Claims 1, 2, 4-9 and 11-23 have been considered but are moot in view of the new ground(s) of rejection.

***Conclusion***

21. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

22. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jeffrey A. Shapiro whose telephone number is (571)272-6943. The examiner can normally be reached on Monday-Friday, 9:00 AM-5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Patrick H. Mackey can be reached on (571)272-6916. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



JAS

June 9, 2007



PATRICK MACKEY  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 3600